

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket № 14311US02)

In the Application of:

Jeyhan Karaoguz, et al.

Serial No. 10/672,653

Filed: September 26, 2003

For: CARD-BASED AND
INDEPENDENT SERVER-
BASED BILLING AND
AUTHORIZATION SYSTEM IN A
MEDIA EXCHANGE NETWORK

Examiner: Alan H. Luong

Group Art Unit: 2623

Confirmation No. 8223

Electronically Filed on August 11, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on April 11, 2008 (hereinafter, the Final Office Action) **with a period of reply through August 11, 2008, pursuant to the attached Petition for One Month Extension of Time.** The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on June 26, 2008 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS / ARGUMENTS

The present application includes pending claims 1-25, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-4, 6-8, and 10-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0059621, issued to Thomas, et al. (hereinafter, Thomas), in view of U.S. Patent No. 6,055,314, issued to Spies, et al. (hereinafter, Spies). Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas and Spies, in view of U.S. Patent No. 7,134,131, issued to Hendricks, et al. (hereinafter, Hendricks). The Applicant respectfully traverses these rejections at least based on the following remarks.

I. The Proposed Combination of Thomas and Spies Does Not Render Claims 1-4, 6-8, and 10-25 Unpatentable

The Applicant now turns to the rejection of claims 1-4, 6-8, and 10-25 as being unpatentable over Thomas in view of Hendricks.

A. Independent Claims 1 and 17

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "a card carrying information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the **user-defined selections identified by the card**, once the card is communicatively coupled to the at least one communication device," as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device.

Spies, in the same field of media exchange; discloses a card (These decryption capabilities are stored on an integrated circuit (IC) card, such as a smart card or PCMCIA card, that is issued to the viewer. **The IC card is configured with cryptographic functionality to support the secure purchase of the**

decryption capabilities from the video merchant. The IC card can then operate in conjunction with a viewer's set-top box (STB), DVD player, or other video computing device to decrypt a video stream of the selected video content program using the purchased decryption capabilities stored on the IC card without exposing those capabilities to the viewer or video computing device; see US'314, col. 2 lines 31-42) **carrying information related to one or more user-defined selections of the information content (the IC card has a pair of public and private exchange keys and a pair of public and private signing keys.** When the purchaser selects a video, the IC card digitally signs the order using the private signing key and passes a credential with the public exchange and signing keys to the video merchant computing unit; see US'314, col. 3 lines 19-24)

See the Final Office Action at pages 3-4 (emphasis added). The Examiner has conceded that Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections, as recited in Applicant's claim 1. The Examiner then relies for support on numerous citations from Spies. In fact, pages 3-5 of the Final Office Action provide extensive summaries of the subject matter of Spies relating to the IC card. By the Examiner's own admission (see bolded portions above), Spies' IC card is configured with cryptographic functionality and is used to support the secure purchase of the decryption capabilities from the video merchant. More specifically, **Spies' IC card is simply used to store the public and private exchange and signing keys that are used to decrypt the video data stream provided from the distribution medium.** See Spies at Abstract and col. 3, lines 36-51. In this regard, Spies' IC card is not used to carry any information related to user-defined selections of information content. Furthermore, the IC card is also not used to access user-defined selections identified by the card.

In the Advisory Office Action, the Examiner relies on col. 6, ll. 25-34 of Spies, which discloses that the IC card 50 can store the cryptographic program key 56. **The Applicants point out that even though the program key 56 can be used by the user to decrypt and watch the purchased DVD, the fact remains that the program key 56 does not identify in any way user-defined selections of information content.**

Therefore, the Applicant maintains that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "a card carrying information related to one or more user-defined selections of the information content, **wherein the card allows the at least one communication device to access the user-defined selections identified by the card,** once the card is communicatively coupled to the at least one communication device," as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Thomas and Spies does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claim 17 is similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 17 is also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Independent Claims 10 and 21

With regard to the rejection of independent claim 10 under 103(a), the Applicant submits that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "wherein the independent server receives one or more user-defined selections of the information content and provides media exchange services related to the one or more user-defined selections of the information content to the first communication device and the second communication device, upon receipt of authentication and billing information for the one or more user-defined selections from the first communication device," as recited by the Applicant in independent claim 1.

The Final Office Action, at page 8, concedes that Thomas does not disclose this limitation and then looks for support to col. 14, ll. 2-7 of Spies. Spies, at col. 14, ll. 2-7, discloses that the cable operator 202 (FIG. 9 of Spies) may perform billing and collection tasks resulting from subscriber rentals. The only storage server disclosed by Spies, and which can be equated to Applicant's "independent server", is the video program storage 214. Even though Spies discloses that the cable operator 202 may perform billing and collection, Spies still does not disclose that the video program storage 214 provides user-defined selections (or any other information) upon receipt of authentication and billing information.

Therefore, the Applicant maintains that the combination of Thomas and Spies does not disclose or suggest at least the limitation of "wherein the independent server receives one or more user-defined selections of the information content and provides media exchange services related to the one or more user-defined selections of the information content to the first communication device and the second communication device, upon receipt of authentication and billing information for the one or more user-defined selections from the first communication device," as recited by the Applicant in independent claim 1.

C. Rejection of Dependent Claims 2-4, 6-8, 11-16, 18-20, and 22-25

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 10, 17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Spies has been overcome and requests that the rejection be

withdrawn. Additionally, claims 2-4, 6-8, 11-16, 18-20, and 22-25 depend from independent claims 1, 10, 17, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-4, 6-8, 11-16, 18-20, and 22-25.

II. The Proposed Combination of Thomas, Spies, and Hendricks Does Not Render Claims 5 and 9 Unpatentable

Claims 5 and 9 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5 and 9.

III. CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-25 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 11-AUG-2008

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